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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,370	11/26/2003	John N. Gross	JNG 98001C	8022

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EXAMINER

SPOONER, LAMONT M

ART UNIT PAPER NUMBER

2626

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/723,370	GROSS ET AL.	
	Examiner	Art Unit	
	Lamont M. Spooner	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 83-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9/14/06 have been fully considered but they are not persuasive.

In response to Applicant's arguments regarding, "...wherein the author of the email message can direct that the email message be transmitted even if the words in such an email message still fall within said language filter." The Examiner notes this limitation is inherently found in Cohen, wherein the author may direct the message to be transmitted, at any time, pre or post edit.

In response to applicant's arguments against the references individually, regarding claim 89, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). More specifically, Cohen provides a particular dictionary, and Ishikawa teaches of a first and a second dictionary, (see previous rejection, see Fig. 5, see Fig. 16A), the Examiner further notes the

separation of dictionaries has many forms, including binary separation, with respect to coding, as broadly interpreted.

In response to applicant's arguments regarding "setting a sensitivity threshold provided by the author to also be used in connection with checking appropriateness of content included in the email message;... The author of the document (web page) has no access to such rating, nor any mechanism for ensuring that the page will comply with such threshold." The Examiner cannot concur, as Russell-Falla explicitly teaches otherwise, see previous rejection (C.5.lines 34-51, wherein "In a preferred embodiment, the software includes means for a parent, guardian, or other administrator to set up one or more user accounts and select appropriate threshold values for each user." The Examiner notes that when the parent, guardian, or administrator is the user, the claim limitation is immediately, inherently met.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is directly supplied in Rayson's summary, , as the both Cohen and Rayson provide filters, and Rayson provides the benefit of scanning, based on indications related to time intervals, for the filtering/corrections, (see previous rejection).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 83-87, 92 and 96 rejected under 35 U.S.C. 102(e) as being anticipated by Cohen (US 5,796,948).

As per **claim 83 and 96**, Cohen teaches a method of permitting an author of an electronic mail (email) message to check text content using an electronic text editor program, the method comprising:

(a) selecting a language filter for checking words in the email message (C.3.lines 32-34), which language filter includes a set of words that could be offensive and/or potentially inappropriate for use in connection with an intended recipient of the email message (ibid, C.4.lines 19-21-as his electronic dictionary-claim 96); and

(b) receiving input words entered by the author as text for the email message (C.3.lines 44-46);

(c) inspecting said input words to determine if they fall within said language filter (C.3.lines 58-63);

(d) alerting the author when one or more of said input words fall within said language filter (C.4.lines 42, 43);

(e) permitting the author to change words within the email message after step (d) and before the email message is transmitted to said intended recipient (C.4.line 42-66); and

wherein the author of the email message can direct that the email message be transmitted even if the words in such email message still fall within said language filter (ibid, interpreted as the author still directing to send the message be transmitted, despite the undeliverable message).

As per **claim 84**, Cohen teaches 83, and further teaches wherein said language filter includes obscene, vulgar and/or racist words found in a first pre-programmed dictionary created without input from the author (C.4.lines 19-21-his defined profanity substrings, and instring functions).

As per **claim 85**, Cohen teaches claim 83, and further teaches providing a highlighting of any words which are determined to fall within said language filter along with an accompanying visual warning (C.4.lines 30, 31-his bracketing).

As per **claim 86**, Cohen teaches identifying a language filter to the author which was triggered during step (d) (C.4.lines 36-38-his profanity message).

As per **claim 87**, Cohen teaches claim 83, and further teaches a step (f): checking one or more additional electronic message files according to steps (a) through (d) (C.4.lines 42, 43).

As per **claim 92**, Cohen teaches claim 83, and further teaches wherein steps (a) through (e) are implemented as a software routine in a machine readable form executable by a personal computer (C.5.lines 28-31).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 88, 89 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of Ishikawa (US 5,812,863).

As per **claims 88 and 89**, Cohen teaches claim 83, but lacks including a step (f): checking spelling of the email message, and further lack wherein said language filter includes a second dictionary with foreign language words..

However, Ishikawa teaches checking spelling (C.3.lines 45-51), and a dictionary with foreign language words (Fig. 5). Therefore, at the time of the invention, it would have been obvious to modify Cohen's email message (document) with spell checking and language filter for foreign language words. The motivation for doing so would have been to have correct spelling and improper foreign language words (C.8.line 66-C.9.line 27).

As per **claim 97**, Cohen teaches claim 96, but lacks teaching wherein said language filter includes at least a first dictionary and a second



separate dictionary, and said alert includes an indication of which of said first dictionary or said second dictionary was triggered by said alert.

However, Ishikawa teaches said language filter includes at least a first dictionary and a second separate dictionary, and said alert includes an indication of which of said first dictionary or said second dictionary was triggered by said alert (Fig. 5 and Fig. 6-his slang dictionary, C.19.lines 51-54). Therefore, at the time of the invention, it would have been obvious to modify Cohen's dictionary with two independent dictionaries. The motivation for doing so would have been identify the dictionary for the correction (Fig. 6-slang, ex. vulgar, standard).

7. Claims 90, 93, 91, 98 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of Russell-Falla et al. (Russell-Falla, US 6,675,162).

As per **claims 90 and 91**, Cohen teaches claim 83, but lacks teaching wherein an author is alerted during step (d) only if a sensitivity threshold specified by the author is exceeded, and wherein said sensitivity threshold is specified as a numerical value ranging from 1 to 10.

However, Russell-Falla teaches wherein an author is alerted only if a sensitivity threshold specified by the author is exceeded (C.5.lines 34-51,

abstract). The Examiner takes Official notice that a sensitivity threshold can have a range of numerical values. Therefore, at the time of the invention, it would have been obvious to modify Cohen's language filter with a threshold specified by an author, wherein the threshold has a range (such as 1-10). The motivation for doing so would have to allow user designate a threshold to filter content (ibid, abstract).

As per **claims 93 and 98**, claims 93 and 98 set forth limitations similar to claim 83 and 91, and are thus rejected for the same reasons and under the same rationale.

As per **claim 99**, Cohen and Russell-Falla make obvious claim 98, Russell-Falla also teaches wherein said sensitivity threshold is used during a check of individual words in said language filter (C.5.lines 65-67, abstract-his email).

8. Claims 94, 95, and 100-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of Rayson et al. (Rayson, US 5,761,689).

As per **claims 94, 95, 100, 101, 102, and 103**, claims 94, 95, 100 and 102, set forth limitations similar to claim 83, and are thus rejected for the same reasons and under the same rationale. Cohen lacks inspecting

said input word substantially immediate in time after it is entered to determine if it falls within said language filter (claims 94 and 100), and further lacks inspecting said input words during idle periods when the author is not interacting with said electronic text editor program to determine if such input words fall within said language filter (claims 95 and 102).

However, Rayson teaches inspecting said input word substantially immediate in time after it is entered (wherein said input word is checked before the author has entered another input word-claim 101), and further teaches inspecting said input words during idle periods when the author is not interacting with said electronic text editor program (C.2.lines 12-24-his automatic as immediate and delimiting as before the user enters another word-claim 100, 101, C.3.lines 24-31-as his spell check, and language filtered as misspellings are interpreted as inappropriate for use in connection with an intended recipient of an email message-claims 102, 103). Therefore, at the time of the invention, it would have been obvious to modify Cohen's language filter with an immediate or after an idle period scan of the words to be filtered. The motivation for doing so would have

been to automatically scan an entry either immediately as input or after an idle period, for correction (see summary).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lamont M. Spooner whose telephone number is 571/272-7613. The examiner can normally be reached on 8:00 AM - 5:00 PM.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 571/272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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SUPERVISORY PATENT EXAMINER

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11/1/06